

To: Scanning (Remsen Bldg _____)

From: Board of Patent Appeals
and Interferences (BPAI)

Scanning Coversheet



Serial No. 09/594459

Incoming _____ **Date Rec'd:** _____

Outgoing X **Date Mailed:** 1/22/08

TOC Code: M327

Document Type: Record of Oral Hearing

Annotations:

Note: This paper has been mailed by
BPAI.

Mail Stop Interference
P.O. Box 1450
Alexandria VA 22313-1450
Tel: 571-272-9797
Fax: 571-273-0042

Filed: January 22, 2008

RECORD OF ORAL HEARING

UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

JAY M. SHORT
Junior Party
(Patent 6,605,449),

v.

PHILLIP A. PATTEN,
and WILLEM P.C. STEMMER,
Senior Party
(Application 10/646,221).

Patent Interference No. 105,532
(Technology Center 1600)

Oral Hearing Held: Thursday, December 13, 2007

Before FRED McKELVEY, *Senior Administrative Patent Judge*,
RICHARD TORCZON and SALLY G. LANE, *Administrative Patent*
Judges.

Interference 105,532

1 On behalf of the Junior Party:

2
3 CHARLES L. GHOLZ, ESQ.
4 DANIEL J. PEREIRA, PhD
5 Oblon Spivak
6 1940 Duke Street
7 Alexandria, VA 22314
8 (703) 413-3000
9

10 KALIM FUZAIL, ESQ.
11 Verenum
12 4955 Directors Place
13 San Diego, CA 92121
14 (858) 526-5403
15

16 JANET M. LOVE, ESQ.
17 Wilmer Hale
18 399 Park Avenue
19 New York, NY 10022
20 (212) 937-7233
21

22 On behalf of the Senior Party:

23
24 R. DANNY HUNTINGTON
25 SHARON E. CRANE
26 Bingham McCutchen LLP
27 2020 K Street, NW
28 Washington, DC 20006-180
29 (202) 373-6077
30

31 ALSO PRESENT:

32
33 DEBORAH KATZ, ESQ.

Interference 105,532

1 *The above-entitled matter came on for hearing on Thursday,*
2 *December 13, 2007, commencing at 1:59 p.m., at the U.S. Patent and*
3 *Trademark Office, 600 Dulany Street, Alexandria, Virginia, before Jennifer*
4 *O'Connor, Notary Public.*

5
6 JUDGE LANE: On the record. This is Interference 105532 .
7 We have a couple of motions that will be argued today.

8 We will start with the senior party, could you please introduce
9 yourself and tell us who -- I am sorry; junior party. Could you introduce
10 yourself and tell me anyone you brought with you?

11 MR. GHOLZ: I am Charles Gholz. I have with me my partner,
12 Dan Pereira. House counsel Kalim Fuzail, and another attorney on our side,
13 Janet Love.

14 JUDGE LANE: Okay. Both of you have 20 minutes,
15 and -- oh. Actually, go ahead Mr. Huntington, and introduce yourself.

16 MR. HUNTINGTON: I am Danny Huntington and I have
17 Sharon Crane from my office.

18 JUDGE LANE: Thank you.

19 MR. GHOLZ: And hopefully, before you turn on the
20 clock -- before we came in here, Mr. Huntington approached me to indicate
21 that his demonstratives have a problem, otherwise known -- well, they have
22 a problem. He would like to take care of it. I would yield the floor to him
23 to take care of it. I was going to object, but if he takes care of it, I don't
24 have to object.

25 JUDGE LANE: Okay. Go ahead.

1 MR. HUNTINGTON: My objections, one and -- um, my
2 demonstratives one and two have the wrong patent. It is a related member
3 of the family that we have actually requested an interference separately. But
4 those are the wrong demonstratives.

5 And I have replacement ones. It is the count -- I am not going
6 to try to put in the claims because I am not going to be talking about them,
7 anyway.

8 But I would like to replace the count with the correct count.

9 JUDGE LANE: Which one is -- so that would be one?

10 MR. HUNTINGTON: Yes, it is demonstrative one.

11 JUDGE LANE: So, that would be one. And you are not going
12 to replace two?

13 MR. HUNTINGTON: I am not going to replace two.

14 JUDGE LANE: Okay. And, Mr. Gholz, are you okay with the
15 replacement of one?

16 MR. GHOLZ: Yes, ma'am.

17 JUDGE LANE: Okay. All right. Okay. So, Mr. Gholz, you
18 have 20 minutes, and you can reserve some time for rebuttal.

19 MR. GHOLZ: Yes, ma'am. We are going to reserve five. I am
20 going to introduce Dr. Pereira, who will be doing most of the arguing.

21 I am only going to argue motion number three, which is an
22 evidentiary motion, a motion to strike recross examination on the grounds it
23 was outside the scope of the direct.

24 This is, as far as I know, the first follow-on to Taskett v.
25 Dentlinger, the infamous case where the Federal Circuit --

1 JUDGE LANE: I am sorry. Let me just stop you there. Are
2 you arguing your motion three right now?

3 MR. GHOLZ: Yes, ma'am.

4 JUDGE LANE: Maybe we can go ahead and do one and two
5 and then come back to three.

6 MR. GHOLZ: Sure. Dr. Pereira?

7 DR. PEREIRA: Good afternoon. As Your Honors know, we
8 have two primary motions here, of course, notwithstanding the motion three
9 on the evidentiary basis. Both threshold motions, one being a Motion of No
10 Interference in Fact; the second, that the Senior Party's claims are
11 unpatentable under ' 112, first paragraph. Those are the motions that have
12 been briefed by both parties and are before you today.

13 I think fundamentally this case comes down to a difference of
14 opinion between our side and the senior party's side as to what the meaning
15 of "non-stochastically assembling" means in the context of Short's claim 1
16 read in light of the specification to which it is attached versus the statement
17 in Patten's claim 275, which says, "reassembling in order."

18 As Your Honors know, we have explained in our motions,
19 together with our oppositions, based on our discussions with our expert,
20 Professor Wittrup from MIT, that read in context of the Short patent, what
21 non-stochastically assembling means -- or it defines a manner in which the
22 building blocks are put together in time and in sequence --

23 JUDGE LANE: Where in your patent specification do you
24 define non-stochastically?

1 DR. PEREIRA: There isn't a definition that says
2 "non-stochastically assembling" as used herein means what we said it means
3 or what our expert says it means.

4 Basically what we had to do, as well as our expert had to do,
5 was take a read through the specification and try to understand what, in the
6 context of that claim and in the context of that specification what that phrase
7 meant.

8 And the conclusion that he came up with, as well as what we
9 came up with, was that, when read in the proper context, non-stochastically
10 assembling -- notwithstanding the absence of a specific definition-- means
11 that those building blocks that are the subject of the manipulation in the
12 method, are put together in a sequential order defining a temporal order of
13 steps in which you put these building blocks together.

14 JUDGE TORCZON: Can we really construe a claim that way,
15 though? We have an obligation to read a claim as broadly as reasonable in
16 light of the specification, it's true.

17 DR. PEREIRA: Uh-huh.

18 JUDGE TORCZON: But at the same time, there is -- if you
19 want to be your own lexicographer, there's got to be a clear quid pro quo.
20 You've got to be pretty explicit in defining it. That hasn't been done here.
21 What authority do we have to limit it to simply what is said in the
22 specification?

23 DR. PEREIRA: Well, it's not just what is said in the
24 specification. And I can't argue that there isn't a specific definition of that

Interference 105,532

1 phrase. But at least my understanding of the law is that a claim is read and
2 understood as one of ordinary skill in the art would understand it.

3 And, as part of that understanding of what that claim term or
4 claim phrase means, one looks to the underlying specification. And that,
5 again based on the opinion of our expert, is what that phrase means. That is,
6 non-stochastically assembling, the manner in which those words are laid out
7 in the claim gives you an indication as to what it is you are doing and the
8 method that is defined in claim 1 of the Short patent, the '449 patent.

9 JUDGE TORCZON: Okay. So, at the minimum, we can't
10 exclude that embodiment. I mean, that is another doctrine that we have in
11 claim construction. It is bad to exclude the preferred embodiment. So, that
12 embodiment we have to include. Why should we limit the claim to that,
13 though?

14 DR. PEREIRA: Again, after consulting with our expert, it was
15 his opinion that any other interpretation of that claim wasn't reasonable.

16 And so then, on the flip side, the broadest reasonable
17 interpretation is the one that party Short has submitted for your
18 consideration.

19 JUDGE TORCZON: Yes, but if we applied that methodology
20 to claim construction, say, where the issue was whether the scope of the
21 claim was supported by the specification, you could never have a scope
22 problem.

23 I mean, the broadest reasonable description would be whatever
24 was disclosed, so you could never have a claim that was broader, and all the

Interference 105,532

1 cases that deal with scope problems were apparently mistaken. And I am
2 having problems applying that kind of methodology here.

3 DR. PEREIRA: I am sorry. I am not certain --

4 JUDGE TORCZON: I am shifting the basis here on you a bit.

5 DR. PEREIRA: Okay.

6 JUDGE TORCZON: If the broadest reasonable construction of
7 a claim is limited to what is actually disclosed, could you ever have a scope
8 problem with a claim, as far as a written description goes?

9 DR. PEREIRA: I think there are two parts to that question, that
10 hypothetical. The first is, I don't think we are trying to necessarily restrict
11 the definition based on the preferred embodiment. What we are saying is
12 that the words, as they mean to one of ordinary skill in the art based on, you
13 know, what is known in this field of technology as well as what is known
14 from the patent -- this is what the words mean.

15 JUDGE TORCZON: Do we have any technical dictionary or
16 anything like that? Any articles that use the phrase?

17 DR. PEREIRA: To my knowledge? No.

18 JUDGE TORCZON: Because, again, we do have plain
19 language here. It says, "non-stochastically assembled."

20 DR. PEREIRA: Uh-huh.

21 JUDGE TORCZON: I don't think "non-stochastic" or
22 "assembled" are disputed.

23 DR. PEREIRA: Right. We don't have a technical definition,
24 you know, from a biotech encyclopedia or publications from science of the
25 cell or anything else like that. But again, I think what we have here is -- so

Interference 105,532

1 you look at the word "assembling." "Assembling" means you are putting
2 something together, right?

3 And then obviously, in this case, as you know, it is these
4 building blocks of nucleotide sequences that we are putting together.

5 The term "non-stochastically" effectively means that we are
6 doing it in an ordered or non-random manner.

7 So, if you put those two words together, we say we are putting
8 these things together-- these things -- sorry. These building block
9 sequences together in a non-random way. We are putting them together in
10 an ordered fashion that yields what it is that we are trying to yield.

11 Now, that of course it is described in the specification.
12 Otherwise, we would have a '112, first paragraph problem, I would
13 presume. That issue is not before the Board today.

14 So, I think, even though we don't have a definition of that
15 phrase, either in the specification or in a textbook, I think when you look at
16 the words, that is the broadest reasonable meaning of what those words
17 mean, contrasting to sort of a randomness of putting together those same
18 building blocks. Other than just saying "assembling them."

19 JUDGE TORCZON: For the purposes of your first submission,
20 though, the No Interference in Fact, I think the relevant corresponding
21 phrase in their claim is "reassembled in an ordered fashion."

22 Why isn't that capturing or at least significantly overlapping the
23 exact same kind of concept?

24 DR. PEREIRA: Well, for fundamentally the same reasons that
25 I have explained with respect to why we interpret our claim one way. When

1 you read -- and that is why we have effectively both these motions. The
2 second one is somewhat contingent on the first, is that when you read the
3 specification of the senior party patent, there is no ordered assembly process
4 in which you are putting together these building blocks -- together in an
5 ordered or sequential, non-stochastic manner, as they have argued.

6 Rather, their assembly processes are entirely random. And so a
7 reasonable -- and presumably the broadest reasonable interpretation in
8 Patten's claim 275 is one that we have submitted for your consideration of
9 the motion one, that is, it is a random assembling process of putting together
10 the building block sequences.

11 If, however, you disagree with us, then we believe that motion
12 two, which is our '112, first paragraph motion, indicates that --

13 JUDGE LANE: Can we get back to motion one for a minute?

14 DR. PEREIRA: Sure.

15 JUDGE LANE: Just a couple of questions. First of all, in
16 Patten opposition one, -- their Statement of Material Fact 51, they point to
17 page 38 of the patent '221 application as showing a non-stochastic
18 reassembly.

19 DR. PEREIRA: I am sorry, Your Honor. Could you repeat
20 that for me, please?

21 JUDGE LANE: Sure. It's patent opposition one, their
22 Statement of Material Fact 51, and they point to page 38 of their
23 specification.

1 And I just wondered if you could explain to me why -- I know
2 you denied that fact without any explanation. I just wondered if you could
3 explain that a little further.

4 DR. PEREIRA: I can certainly try, but, as you know, I am not
5 the expert. But we did go through all of these examples with our expert.
6 And I am not going to do it justice in terms of the methodology of what is
7 described here, but I will give it a shot.

8 Basically what you are doing here is you take a series of
9 template DNA molecules. You design a series of what they call
10 bridging -- or bridging all of the nucleotides, that would bridge the different
11 sections you want to recombine from your different starting templates.

12 You throw the whole mix into a reaction tube with the
13 appropriate buffers and enzymes and precursors, etc., and you let it run.
14 And then based upon the fidelity or lack thereof of the polymerase that is
15 used for the amplification reaction, you get effectively a piece from one
16 template that bridged through the nucleotide to the second template, so you
17 would have, you know, one and two put together.

18 But the events -- the order of events in which it happens -- in
19 other words, mixing one and two and three and four -- are relatively at
20 random and to a large extent, based on the hybridization -- I should say
21 the -- all of the nucleotide probes finding the template of a certain portion
22 and then jumping to a second portion.

23 There is not really much order going on in that reaction. So, at
24 least -- again, based on the consultation with our expert, that is a pretty

Interference 105,532

1 random process in terms of how those different blocks from the different
2 templates are shuffled together.

3 JUDGE LANE: Okay. Another question on your motion one.
4 What evidence do you have that the patent method isn't obvious? I know
5 you talked a lot about them not being the same, but why is the method not
6 obvious?

7 DR. PEREIRA: The two methods?

8 JUDGE LANE: Yes. Why is the patent method not obvious?

9 DR. PEREIRA: Well, it is a good point. It is a point that we
10 raise in our motion one. That is, that you wouldn't -- one wouldn't actually
11 do what we are doing going from what the patent described. There is a
12 disincentive to do it. It is more cost burdensome. It is more difficult to
13 control -- not more difficult to control, it is more difficult to enact or to
14 perform the method.

15 JUDGE TORCZON: But you get a better process -- product,
16 right?

17 DR. PEREIRA: You do get a better product. That is correct.

18 JUDGE TORCZON: So, I mean, that is a common trade-off in
19 life. You pay more, you get a better product, so --

20 DR. PEREIRA: But our expert, Professor Wittrup, had done
21 some of these types of shuffling experiments himself in his lab some years
22 ago, and to his recollection, it would be -- you just wouldn't do it. There
23 was a disincentive to do it. In other words, having this art established meant
24 that mixing everything up in a tube would -- you affectionately call it the

Interference 105,532

1 random reassembly process of the patent -- you wouldn't really go looking
2 for another way to do it.

3 And you wouldn't want to do it because of all these additional
4 burdens that would be placed on the user or the lab technician to do those
5 experiments.

6 JUDGE TORCZON: Except you could get a better product.

7 DR. PEREIRA: You do get a better product.

8 JUDGE TORCZON: I mean, I am just thinking, if I go into the
9 marketplace, and I say, you know, you can have a \$20,000 car that is okay,
10 or you can have a \$40,000 car that is terrific. There is going to be at least
11 some percentage of the market that is going to go for that, and there is going
12 to be some percentage that is going to go for the \$500,000 car.

13 DR. PEREIRA: A smaller percentage, but yes.

14 JUDGE TORCZON: The point, though, is cost is relative to
15 the quality of the product, or at least the perceived quality of the product.
16 So, why isn't that incentive enough -- if you know how to do it, to do it? At
17 least for some fraction of the market?

18 DR. PEREIRA: I didn't do a market analysis for this, so I can't
19 answer that question directly. I just have to argue that -- you know, we
20 talked about these issues with our expert and these were the -- going back to
21 around the mid to late nineties when the relevant time frame here is,
22 somebody just wouldn't do it.

23 He was doing basically similar types of things the patent is
24 describing in their application and there would be no reason to do it. And
25 you just wouldn't do it. It is not like -- you wouldn't know that you had a

Interference 105,532

1 better product until you did it. But you wouldn't do it because you didn't
2 want to do it.

3 So, while the analogy to the car industry I appreciate, you
4 wouldn't know that you would have a better car at \$40,000 unless you
5 actually did it, but you wouldn't do it because you wouldn't want to do it.
6 It's sort of --

7 JUDGE TORCZON: Until you build the car with the leather
8 seats, nobody knows whether they want to pay more money to get that car. I
9 mean, there is a certain circularity to that argument.

10 DR. PEREIRA: Unfortunately, yes. There is a bit of
11 circularity there. I admit it. But that is the -- as far as I understand it, the
12 reality of the situation.

13 JUDGE LANE: But wouldn't it make sense that an ordered
14 product would be more desirable?

15 DR. PEREIRA: Yes, but again, based on what I understand
16 about the techniques, you -- and we have certainly made it of record, you do
17 get some ordered product in these random processes the patent describes.

18 And for most folks, that's just fine. In other words, you do get
19 some ordered products. And there is no need to go messing around with the
20 system to get something different.

21 It just turns out that somebody took the incentive to do what
22 they did -- "they" meaning Short -- that gave you tighter control of the
23 system, and gave you heads and shoulders above the others, better products,
24 reduced background and at the end of the day was an overall better process.

1 But again, you really wouldn't know that until you did it. But
2 you wouldn't do it because nobody wanted to. I mean, I understand the
3 circularity of that argument. But I am sort of a communicator, not the
4 expert, so.

5 JUDGE McKELVEY: I have a question.

6 DR. PEREIRA: Yes, sir?

7 JUDGE McKELVEY: Does your disclosure support an
8 invention that is broader than what is in your claim if "non-stochastically"
9 were taken out?

10 DR. PEREIRA: Yes, sir. My recollection is, I believe it does,
11 in that there are a number of processes described in the Short patent that are
12 not non-stochastic, to use a double negative. In other words, are stochastic
13 in their nature, for which the building blocks are put together.

14 There is some discussion of that, I believe. So, I think a
15 modifier of non-stochastically assembling does mean something here.

16 JUDGE McKELVEY: How did it come about that this
17 limitation was put in the claim?

18 DR. PEREIRA: Well, I wasn't the prosecuting attorney, so I
19 don't know exactly what was in the minds -- or what was going on at that
20 time. I only presume that the way the amendment was performed -- was
21 written and submitted to the Patent Office was to make it more clear as to
22 how the assembling process was being conducted.

23 And that, of course, as we know, as we stated, was modified by
24 the term, "non-stochastically."

25 JUDGE McKELVEY: Okay. Thank you.

Interference 105,532

1 JUDGE LANE: Do you want to talk a few minutes about your
2 motion two?

3 DR. PEREIRA: How much time do I have left?

4 JUDGE LANE: You all have about five or six minutes. But go
5 ahead. We have asked questions, so you can have --

6 DR. PEREIRA: A minute or two on motion two, if you will
7 bear with me, because I think fundamentally the issues that we have already
8 talked about with respect to motion one are clearly relevant for motion two.

9 And that is, as Your Honor has already -- we have already
10 looked a little bit at the patent '221 application. All the methodologies in
11 there are, as we call them, a random assembly process. In other words, you
12 are putting these building blocks in just a random mix with no order or real
13 control as to how those blocks would be put together.

14 Now, obviously for the reasons we have explained in our
15 motion one, and we have talked a bit about today, we think that the claims
16 are different if read in light of their respective specifications.

17 However, if Your Honors believe that the broadest reasonable
18 interpretation of the Patten's claim 275 is such that it is also covering a
19 non-stochastic assembling process, we have submitted to you and have
20 asked you to consider that that isn't actually described by Patten in their
21 application because all of the processes are random --

22 JUDGE McKELVEY: I am having trouble with this argument
23 of yours because in connection with the No Interference in Fact motion, the
24 issue is, as I see it, is whether the subject matter of the Patten claim renders
25 obvious this -- your subject matter.

1 DR. PEREIRA: That's one component. The other component
2 is whether or not they are the same invention. So, the first thing --

3 JUDGE McKELVEY: You would concede, wouldn't you, if
4 you are first, that their claim is unpatentable?

5 DR. PEREIRA: Well, that would be the -- if you buy into their
6 argument, their patent's argument that their claim is --

7 JUDGE McKELVEY: No, I am asking a simple question. If
8 you have established priority of your claimed subject matter --

9 DR. PEREIRA: Uh-huh.

10 JUDGE McKELVEY: Prior to their date, then their claim is
11 unpatentable, isn't it?

12 DR. PEREIRA: Well, we think that they are different claims.
13 And so they are not the same. And so our claim wouldn't necessarily have a
14 bearing in isolation on Patten's claim 275.

15 JUDGE McKELVEY: So, you don't concede you are a
16 subgenus of their genus?

17 DR. PEREIRA: No, sir. There are different methodologies.

18 JUDGE McKELVEY: Okay, but once you are past the No
19 Interference in Fact, then isn't the only issue with respect to description
20 whether they have described what they have claimed?

21 DR. PEREIRA: Well --

22 JUDGE McKELVEY: Regardless of what you think your
23 invention is.

24 DR. PEREIRA: Well, motion two is largely contingent on
25 motion one. That is --

1 JUDGE McKELVEY: Why is that? That is what I can't
2 understand.

3 DR. PEREIRA: Okay. Well, we have submitted and we have
4 asked the Board to consider that the claims are different. The claims are
5 different because when read in light of their respective specifications, Patten
6 claim 275 is not a non-stochastically assembling process. Rather, it is a
7 random assembling process that provides some ordered products at the end
8 at some frequency.

9 JUDGE McKELVEY: Okay. Suppose I concede that to you.

10 DR. PEREIRA: You concede that to me. Okay.

11 JUDGE McKELVEY: I concede that to you. You know, they
12 don't have "non-stochastically." But why don't they support the claim they
13 have in here?

14 DR. PEREIRA: If the Board finds that Patten's claim 275 is a
15 stochastic assembling process and Short's patent claim 1 is a
16 non-stochastically assembling process, then they need not further consider
17 motion two. Because we can see that Patten's claim 275 when read in light
18 of their specification describing a random assembling process, is described
19 by Patten's '221 application.

20 What it doesn't describe is a non-stochastic assembling process,
21 as they have asserted from the outset of suggestion of interference
22 documents.

23 JUDGE McKELVEY: But they don't have to describe your
24 invention. They just have to describe their own invention.

25 DR. PEREIRA: That is correct.

1 JUDGE McKELVEY: And then the issue becomes whether
2 there is an interference in fact between these two inventions that are
3 "different."

4 DR. PEREIRA: Yes.

5 JUDGE McKELVEY: I don't see how your motion two can
6 possibly be granted, as I am sitting here right now.

7 DR. PEREIRA: Well, I guess the answer to the question is, it
8 depends. It depends on how you decide motion one, is the determination --

9 JUDGE McKELVEY: That's what I can't figure out. I can't tie
10 the two together. I can't see what you are claiming has anything to do with
11 whether they have described the invention in their application.

12 DR. PEREIRA: No, it really is separate from what we are
13 claiming. I think -- I don't want to be repetitive, but I'll say it again. That
14 is, that Patten's claim 275, we believe, when read in light of their
15 specification, means a stochastic assembling process. You may disagree
16 with us. You may think that it is broad enough to read on a stochastic and a
17 non-stochastic assembling process.

18 If you decide that Patten's claim 275 reads on a non-stochastic
19 and a stochastic assembling process, then we would submit to you that that
20 claim is not supported under ' 112, first paragraph, by their specification
21 because they only describe a random assembling process, and their claim
22 has overshoot what they described.

23 JUDGE TORCZON: Isn't there a third route --

24 JUDGE McKELVEY: What you are saying is that if what they
25 are claiming includes two embodiments, at best they only describe one, and

Interference 105,532

1 therefore have no business claiming something that covers two
2 embodiments?

3 DR. PEREIRA: That's a fine way or restating it, yes, sir.

4 JUDGE McKELVEY: I am saying that a little crudely, but you
5 get the point.

6 DR. PEREIRA: I think it was perfect. Thank you.

7 JUDGE McKELVEY: Okay. Thank you.

8 JUDGE TORCZON: As I see it, you are framing it as an
9 either/or issue, and I am thinking that there may be a third alternative. Isn't
10 it possible that you have described your claim, and they have described their
11 claim, and they don't line up exactly? There are differences, which leads us
12 into the question of whether those differences are obvious.

13 So, if it comes down not to an anticipation analysis, in the first
14 motion, but an obviousness motion, is there really any connection between
15 the motions at that point? I mean, they don't have to describe your
16 invention to render it obvious.

17 DR. PEREIRA: They ought to come pretty close, though.

18 JUDGE TORCZON: And then that's a separate question.

19 DR. PEREIRA: But no, I think if --

20 JUDGE TORCZON: But there is no necessary connection,
21 given the possibility of an obviousness analysis.

22 DR. PEREIRA: Well, I think if you get to the point where you
23 agree with us that the two claims are different claims and they are not
24 anticipatory of each other, if you will, then -- Judge Lane and I just had a

Interference 105,532

1 conversation a few minutes ago about the aspects of obviousness when we
2 talked about the \$500,000 cars and things like that --

3 (Laughter.)

4 DR. PEREIRA: But that is where ultimately the analysis will
5 come down, in determining whether or not there has been an interference
6 here or not.

7 JUDGE LANE: Okay. All right. I am going to let Mr. Gholz
8 take a minute if he wants to address motion three.

9 MR. GHOLZ: Thank you, ma'am.

10 JUDGE LANE: I think your time is up, but one minute. And
11 you can reserve.

12 MR. GHOLZ: Thanks. This is a chance to revisit Taskett v.
13 Dentlinger. That is the case where the Federal Circuit said that you have
14 discretion to not enforce the normal rule that cross has to be within the
15 scope of the direct, that redirect has to be within the scope of cross, etc.

16 But you certainly have discretion to let the evidence we are
17 objecting to into evidence. But discretion should be fact-based. It should
18 be based on what's going on here.

19 In the famous words of First Assistant Commissioner
20 Reynolds, quoted approvingly in Myers v. Feigelman by Judge Rich, "If we
21 don't enforce those rules, just because there is no particular harm to the
22 other side, to us that comes, if those questions had been asked the first time
23 at bat, they would have been just fine."

24 The problem here is they weren't asked in cross. They were
25 asked in recross. So, if you say, well, no harm here, because they could

Interference 105,532

1 have been asked in cross, then you are ignoring the regular orderly
2 procedure that each time at bat in an interference, well, in any litigation,
3 actually, should be limited to what happened in the previous time at bat.

4 To hold that this rule be ignored in the absence of such
5 circumstances merely because no special damage has been shown would
6 defeat the purpose of the rules and substantially confuse interference
7 practice. It would mean cross, recross, redirect, redirect -- it would go on
8 indefinitely. This is supposed to be a narrowing passageway. Each time
9 should be within the scope of the last one.

10 I submit that you should enforce the customary rule. And if
11 you read the recross, it's got nothing to do with the redirect. Nothing. This
12 isn't a obviousness question. This is just -- it went back to a different issue
13 entirely.

14 JUDGE LANE: Thank you.

15 MR. GHOLZ: Yes, ma'am.

16 MR. HUNTINGTON: May I approach the bench?

17 JUDGE LANE: Sure.

18 MR. HUNTINGTON: Part of the confusion, I think, here is
19 trying to give this special meaning to "non-stochastically." The real issue
20 here is temporally non-stochastically versus spatially non-stochastically.
21 And if you look at it from that point of view, I think the whole thing will
22 make a lot more sense. I will explain as I go along.

23 But Short's discussion of the technology ignores the Short
24 specification and claims in this interference. I think it is very telling that the

Interference 105,532

1 demonstratives that they submitted and the motion itself don't set forth the
2 count.

3 They really don't want to talk about the count because they
4 want the claims to mean what they want them to mean, not what they
5 actually say. So, in trying to come up with a winning argument, they ignore
6 what they said about the technology in their own specification. They ignore
7 what they said about claim 1 during -- what became claim 1 during their
8 prosecution. They ignore what they said when they filed the reissue
9 application. And they ignore what their expert said when he looked at claim
10 13 of the reissue application.

11 So, I am going to talk about those four, rather than the broader
12 thing because I think it is clear here that if you give Short claim 1 the
13 broadest reasonable interpretation, it is not limited to step-wise. It is simply
14 unreasonable to limit it to step-wise -- to temporal non-stochastically. In
15 other words, the spatial non-stochastic assembly that is in the senior party's
16 application falls within their claim.

17 And since it does, the claims are -- actually cover the same
18 subject matter. There is anticipation in both directions, not just that --

19 JUDGE LANE: So your position is that your claims cover
20 step-wise?

21 MR. HUNTINGTON: Our claims are broad enough to cover
22 step-wise, yes. Because it talks about -- the specific language talks about
23 "reassembling said defined polynucleotide segments in order." Now, it is
24 broad enough to include it because that -- even though the specification
25 doesn't specifically recite it.

1 I mean, it is true that within our specification, within the senior
2 party's specification, the examples are directed to something that is
3 spatially -- in other words, taking these and lining them up, one, two, three,
4 four. It is true that it is all thrown into one pot to have that occur, but you
5 end up with molecules that are one, two, three, four, in exactly the same way
6 they would.

7 JUDGE LANE: So in all your embodiments, it is the throwing
8 into the pot?

9 MR. HUNTINGTON: Yes.

10 JUDGE LANE: You don't have any way you do this
11 step-wise?

12 MR. HUNTINGTON: We do not discuss step-wise. I think if
13 you wanted to, you could go back and say that the first manipulations were
14 step-wise. And I mean, you look at their claim, it is broad enough. It
15 doesn't say that it can't be two pieces of DNA, two nucleotide sequences,
16 that they put together like this.

17 I mean, that is what the first ligations were.

18 JUDGE TORCZON: So, sort of the null case of a non-stick
19 aspect?

20 MR. HUNTINGTON: Yes. That's right.

21 JUDGE TORCZON: So, we only have a problem when we
22 have more than two used?

23 MR. HUNTINGTON: Well, when we have more than two, and
24 you have to do some other things to make it end up right. In other words,
25 you have the overhangs. If the overhangs are unique, then you are not going

Interference 105,532

1 to have a problem, either. And so, that is the kind of -- kind of how you do
2 it.

3 So, why don't we talk about what they said about assembling in
4 their specification. I want to talk about that first. So, the first thing is, you
5 already talked about the fact that there is no definition in the patent. And in
6 fact I asked their expert about that, and he agreed that there wasn't anything
7 close.

8 Now, it does appear -- the word "assembling" appears in a
9 couple of passages. But when you look at that, it is in connection with both
10 types of processes. For instance, if you look at column 58, lines 16 through
11 24 of the patent, of the Short patent, it says, "The final chimeric nucleic acid
12 molecule may be generated by sequentially assembling two or more
13 building blocks at a time until all of the designated building blocks have
14 been assembled" -- I am going to skip the next sentence.

15 But in the same paragraph, it says, "Alternatively, the final
16 chimeric nucleic acid molecule may be generated by assembling all of the
17 designated building blocks at once in one step."

18 JUDGE TORCZON: So why didn't they just describe two
19 different embodiments? They are claiming one now.

20 MR. HUNTINGTON: They could if it was clear that they were
21 claiming one, but that is not the only passage like that. There are other
22 passages, including when they put the claim in, when they said that they
23 weren't claiming just one of their embodiments.

24 JUDGE LANE: Why is "at once in one step" not stochastic?

Interference 105,532

1 MR. HUNTINGTON: Because if the final chimeric nucleic
2 acid molecule has an overall order, then it's not --

3 JUDGE LANE: So, the one they are describing at column 58,
4 you say that was an overall predetermined order?

5 MR. HUNTINGTON: Yes. They make it very clear in context
6 that their hope -- that their entire patent is directed to the idea of forming
7 ordered molecules. Now, you can have two different ways you can form
8 ordered molecules.

9 You can do it by adding the building blocks one at a time,
10 which is step-wise. Or you can do it by designing the molecule, the various
11 building blocks in such a way that they line up and give you an ordered
12 molecule at the end of the day.

13 JUDGE TORCZON: Eventually you run out of options to do
14 that, though. I mean, there are only so many overlaps you can design before
15 you start running into problems.

16 MR. HUNTINGTON: Actually, if you look at what they say
17 about overlaps, you may run into problems in terms of stoichiometry, but
18 the -- how long they are -- but if you look at column 58, lines 3 to 15, they
19 say an overhang may be comprised of any number of nucleotides. It is
20 preferably zero nucleotides, or a blunt end, to 10,000 nucleotides.

21 I submit that it would be a long time before you run out of
22 unique sequences with 10,000 nucleotides.

23 JUDGE TORCZON: It would be hard to get 10,000
24 nucleotides to work.

Interference 105,532

1 MR. HUNTINGTON: I agree. I am not arguing with that. If
2 you look at it, they say that most preferred is 1 to 200 nucleotides, which is
3 a reasonable number.

4 My point is, when you look at the claim, there is no limitation
5 on how many pieces it has to be. That claim was broad enough, as I said, to
6 include two -- even in their patent, they agree that up -- they have a figure
7 that shows 12 possible unique sequences where they could make them up
8 and have them bind uniquely.

9 And keep in mind that there is nothing about unlimited
10 background. It doesn't say all of the sequences have to be like that. If you
11 look at the passage at column 2, lines 48 to 57 of their patent, it says, "It is
12 appreciated that the presence of background products in some quantity is a
13 reality in many reactions where molecular processing occurs, and the
14 presence of these background products does not detract from the
15 non-stochastic nature of a mutagenesis process having a predetermined
16 product."

17 JUDGE TORCZON: Is there a difference between "some" and
18 "preponderantly"?

19 MR. HUNTINGTON: Well, it is not clear what
20 "preponderantly" is. I agree that there are reactions in which there will be a
21 lot more background. But if you look at this particular claim, it doesn't
22 specify what the level is. In fact, Short's expert, in Exhibit 1003, at page 28,
23 lines 9-13, I asked him, "I would like for you to look at claim 1 here, of the
24 Short patent. Where does it say in that claim that any particular percentage
25 of the sequences must be the desired ones?"

Interference 105,532

1 And he said, "It doesn't."

2 JUDGE TORCZON: You basically argue for two sort of
3 genres of non-stochastic. There is the step-wise, and there is the spatial.
4 They may overlap some.

5 MR. HUNTINGTON: Uh-huh.

6 JUDGE TORCZON: Do we have to construe your claim to
7 cover both before there will be an interference?

8 MR. HUNTINGTON: No. No, because the Short claim covers
9 both. And so, even if you construe ours to just cover one of them, there is
10 still an interference because if they have two embodiments and we have one
11 of those two, there is still an interference in fact.

12 JUDGE LANE: If we actually construe their claim to be
13 limited to the step-wise, would there be an interference?

14 MR. HUNTINGTON: If theirs was construed to be step-wise,
15 then I think they haven't dealt with the obviousness question. They dealt
16 exclusively with the question of whether they were, you know -- the same
17 thing.

18 I don't remember any evidence with respect to obviousness.
19 And it was their burden to present it. So, you would have to find not only
20 that they were limited to step-wise, but they had also proven that the spatial,
21 which is admittedly prior art, wouldn't make that obvious and vice versa. I
22 just don't think there is any evidence in the record on that.

23 The other thing that I --

1 JUDGE McKELVEY: Is it your position that if you have two
2 building blocks in your process in there that you are necessarily going to get
3 the same product?

4 MR. HUNTINGTON: You're going to get at least -- well, if
5 there's only two, you probably will get the same product in both. The
6 more --

7 JUDGE McKELVEY: You said "probably." Is there some
8 expert tells me this on the case besides you?

9 MR. HUNTINGTON: There is -- yes. I am not --

10 JUDGE McKELVEY: Otherwise, we will have
11 cross-examination right here in the room.

12 MR. HUNTINGTON: Oh, please don't.

13 (Laughter.)

14 MR. HUNTINGTON: Now, I did ask that question specifically
15 of the expert. I asked him isn't it true that in both the process that is
16 described in the Short patent and the process that is described in the patent
17 application, that you will get some desired products, and he said yes.

18 You just get more when you do step-wise than you will in the
19 other. There may be circumstances under which it won't be different. But
20 he did agree specifically that you would get the -- you would get some
21 desired product in both situations.

22 When the -- claim 1 of the Short initially put in prosecution
23 had -- Dr. Crane reminds me that our "reassembled in an ordered fashion"
24 also talks about encoding an enzyme, so it is actually directed more to claim

Interference 105,532

1 6 of the Short patent because we have taken the position that claim 1 is so
2 broad that it reads on two pieces of DNA that don't have any utility.

3 But that is not an issue that is here today. But I would point
4 out that there is some additional language in there to make our claim
5 patentable that isn't in Short's claim 1.

6 But going back to their original prosecution, their original
7 claim for that step B said, "Assembling the nucleic acid building blocks
8 such that a designed overall assembly order is achieved." So, it didn't have
9 the word "non-stochastically."

10 Then they put in claim 3, which ultimately became claim 1 of
11 the patent, and when they put that in, in the remarks section, they said, "The
12 applicant respectfully submits that the present amendments do not narrow
13 the scope of the claimed invention or surrender the subject matter of the
14 invention in any way."

15 "Specifically, the applicant respectfully submits that the present
16 amendments present no narrowing to meet any statutory requirement, either
17 voluntarily or to overcome or to distinguish the claimed invention from
18 prior art" and it goes on from there. This is on page 2 of their amendment.

19 So --

20 JUDGE TORCZON: This sounds like post-Festo boilerplate.

21 MR. HUNTINGTON: In fact, Festo is cited at the end. And it
22 may be boilerplate, but it is intrinsic evidence. It is part of their file wrapper
23 where they said this new claim that has the word "non-stochastically" in it
24 doesn't -- isn't narrower at all than without the word "non-stochastically" in
25 it.

1 JUDGE TORCZON: The paradox here is if somebody were
2 pointing to such language to say that in fact their claim was narrower
3 usually we would ignore it. We would say we can't do that. If you want it
4 narrowed, you have to make it narrow.

5 So, why should we do the reverse? If somebody says, our
6 claim is really broad, does that force us to give a broader reading than we
7 otherwise would?

8 MR. HUNTINGTON: No, I don't think it forces you go give a
9 broader reading, but I think it is evidence to say that non-stochastically
10 doesn't have to mean step-wise, that it can mean step-wise and temporal.
11 And it could include both of those as opposed to a purely random process,
12 which is out there, where you just take pieces of DNA, you throw them in
13 there, there is no design, you just throw them in there, and then what you get
14 out -- various molecules, and then you test them to see if any of them have
15 properties that are desirable.

16 So, it is distinguishing from other processes. It makes it clear
17 in the background that that's the difference between a non-stochastic or
18 non-random process, as opposed to a random process.

19 The two types of processes that are described in Short and the
20 one process that is described in Patten are both non-random processes. And
21 we have one of the two in the Short patent and their claim under the
22 broadest reasonable interpretation shouldn't be limited to that.

23 Now, the other thing that is --

24 JUDGE McKELVEY: You are saying though, that we should
25 just continue to ignore this word, "non-stochastically" in the claim? If they

1 say it doesn't narrow it, a claim with that word and a claim without it are the
2 same?

3 MR. HUNTINGTON: I am saying that it emphasizes the fact
4 that it is not a random process. So, it is useful in making it clear that it's not
5 random. But it doesn't have the further ability to go and limit it to
6 step-wise.

7 Because if they want to say step-wise, they can. I mean, if we
8 look at claim 13 that they put in, in their reissue application, it says
9 specifically, "ligating the building block sequences step-wise in a
10 deliberately chosen order in order to produce a chimerized polynucleotide
11 sequence."

12 So, if they want to say step-wise, they can do it rather than
13 using this. And, you know, they argue that -- whether they were talking
14 about ligating, not the step-wise.

15 But when I talked -- I asked about this. As a part of -- whether
16 they were talking about -- as a part of the expert -- in their remarks in their
17 reissue application, in this amendment, they said, "Claims 13 through 17 are
18 newly added in order to specify specific embodiments within the scope of
19 previously allowed claim 1." This non-stochastically claim, now they are
20 saying step-wise is an embodiment within that.

21 And when I asked the expert about that, I looked at that, and I
22 said -- I referred him to that passage, and I said wouldn't it look like the
23 step-wise is a specific embodiment within the scope of the
24 non-stochastically assembling? Isn't that what it looks like to you?

1 And he said, "Well, it is a term of art. I don't use the term
2 'specific embodiment' that often. But I will say that's what that sentence
3 says."

4 And then I went on and I asked him about this new claim 13.
5 And I said, so this claim, claim 13 -- it was very clear that what is meant is
6 that building blocks are assembled step-wise, and you don't have to do any
7 interpretation to understand that, do you.

8 And the expert said, "It is less ambiguous than the earlier
9 wording in the original claim 1." So, he -- even the expert agrees that it
10 was -- that it is ambiguous the way it's set up.

11 And that ambiguity goes against them. They wrote that claim.
12 They have to decide what that claim means. And that claim is broad enough
13 to include both of the embodiments that they have in their case, because I
14 don't think there is any question from what I have read before that their
15 specification includes both embodiments.

16 To say that this language which they never said anywhere
17 during prosecution or anywhere else in their specification, all of a sudden in
18 an interference it means step-wise, I think is just a litigation-driven
19 argument.

20 It should be what they said all along. And when you look at
21 these things that I talked about, the claims shouldn't be limited to step-wise.

22 It should be the broader interpretation.

23 And with that broader interpretation, then if it includes both of
24 them, then it includes what we have, because we clearly have

Interference 105,532

1 the -- something that is ordered, putting it in a pot and doing it all at one
2 time. That is basically motion one.

3 Motion two with respect to the claim -- the claim is supported
4 by the specification. We haven't limited it to that. We do have everything
5 that's in that claim. To say that it perhaps doesn't -- you know, that -- how
6 shall I put it? We don't have to write a claim that carves out something that
7 came later. I mean, the fact it's step-wise is something that they came up
8 with at a later time. It doesn't make our claim have '112 support.

9 Our claim as it's written clearly has support. If you look at
10 the -- you asked earlier, Judge Lane, about Fact 51 of the motion -- in our
11 opposition, I guess, actually. And we talk about that. You will see at Fact
12 No. 52, we state, "The method of Patten claim 275 is further supported by
13 the examples set forth on pages 91 through 93 of the Patten '221
14 application." And it refers to -- there is an example there. The example
15 shows taking various building blocks, throwing them in a pot at one time, to
16 do some modification of interferon.

17 JUDGE LANE: But you agree you don't describe step-wise.

18 MR. HUNTINGTON: We do not describe it. In fact --

19 JUDGE LANE: So, your claim doesn't include step-wise?

20 MR. HUNTINGTON: Right.

21 JUDGE TORCZON: But your claim doesn't include it, or you
22 are saying it is not a problem that it does include it?

23 MR. HUNTINGTON: Well, it could be read broadly enough to
24 include it. But that doesn't make the claim objectionable under '112.

1 JUDGE TORCZON: So if we read it as not including
2 step-wise, that wouldn't give you -- you would say that is a correct
3 construction?

4 MR. HUNTINGTON: That is a possible construction, and that
5 would be okay.

6 JUDGE TORCZON: If we read it broadly enough to cover
7 both, because we always try to construe stuff broadly or else we get
8 reversed -- you don't have a problem though.

9 MR. HUNTINGTON: I don't have a scope problem because
10 my claim is commensurate in scope with what I have described. In other
11 words, if you think about it in a genus/species relationship -- I can have an
12 earlier case that describes the genus. If I try to claim a species that I don't
13 describe, then I've got a problem.

14 Because then my claim is covering something I don't disclose.
15 But if I put the word "step-wise" in my claim -- yes, I would have a
16 problem. But as it stands right now, I don't. My -- the fact that somebody
17 can look at it and say, oh, here's an embodiment that falls within your claim
18 that you don't describe doesn't make my claim unpatentable.

19 JUDGE TORCZON: I am wondering, though, if the better
20 analogy here isn't something more like Morse, though, where Morse invents
21 the telegraph, and he's got the infamous claim that any electrical
22 communication at a distance, which would cover television, telephones and
23 all sorts of stuff which he clearly didn't invent.

24 I am wondering if this is not so much a genus/ species problem
25 as two separate genuses -- genera. I'm sorry.

1 MR. HUNTINGTON: I have to say, I haven't thought of that.
2 It's more complicated than I can think of right now. I simply say that with
3 respect to our claim, I have looked at it. We explain in our request for
4 interference and more recently where all of the limitations that are in that
5 claim appear in our case. We have exemplary support or something that
6 falls within it. Except for the fact that it's -- we have an example. And the
7 only difference between that example and the claim is interferon is not an
8 enzyme, but we have other disclosure that talks about enzymes.

9 I don't think there is any question but what we describe
10 something that will work within that. I think we would only get into a
11 problem if we went and tried to construe our claim to be the same as theirs.

12 You see, I think their claim two genres. I mean, their claim is
13 a genus. I should say -- not two genres. Their claim is a genus. It has two
14 possibilities. It does cover step-wise. They have step-wise claims now, but
15 they are in the reissue, not in this case.

16 And so from that point of view, it is the same.

17 JUDGE LANE: Do you want to just take a minute, maybe to
18 respond to Mr. Gholz' argument on motion three, if you would like.

19 MR. HUNTINGTON: With respect to motion three, I will
20 simply rest on the fact that he wanted to talk about that first. So, he didn't
21 want to talk about the facts here. If you would like to dump that testimony, I
22 don't think it makes a big difference. It's good testimony, and I do think it
23 was proper. I explain it in my paper. But I don't see any reason to take
24 time -- take your time to talk about it.

25 JUDGE LANE: Okay, thank you. Rebuttal?

1 JUDGE McKELVEY: How about Mr. Huntington's argument
2 that you put the amendment in and you said the claims weren't narrower?

3 DR. PEREIRA: Well --

4 JUDGE McKELVEY: Then you put in a reissue and you said
5 step-wise. So, how come your claim doesn't cover the two embodiments?

6 DR. PEREIRA: Fair question. On your first question, on the
7 amendment. Don't know why it was said when it was said at that time. I
8 wasn't the attorney. Clearly, I think we all recognize it's just a canned piece
9 of language used somehow preserve an option of the doctrine of equivalents
10 under Festo in a later litigation, should that ever happen.

11 JUDGE TORCZON: I think in that context, you get the benefit
12 of it, so -- if Mr. Huntington's right that it means that it was always
13 interpreted broadly, why shouldn't we give that credit?

14 DR. PEREIRA: I think if we were in a litigation on that issue,
15 the court would still take it under advisement as to whether or not factually
16 there was a significant difference in terms of a narrowing amendment
17 related to patentability under Festo, and whether the doctrine of equivalents
18 would still be applicable.

19 And just as a second point on that, before I get to the reissue,
20 Your Honor, was the -- when we said, and I think it was in our reply one,
21 there's law that says if an attorney says something that is blatantly wrong, it
22 doesn't undermine what the factual issues are there.

23 That is, I could change the sky is any color to the sky is blue,
24 and I say that is not a narrowing amendment. But clearly I have narrowed

Interference 105,532

1 the definition of what color the sky is. So, I -- regardless of what's there, I
2 think the facts are what they are.

3 As to the reissue question, as with many things, I think that
4 Patten wants to put forward -- if you take things out of context, or just look
5 at a particular word and what a word means, yes. You know, they can have
6 a vast number of different meanings, inclusive of broader subject matter or
7 not.

8 And as we have said in our reply, as we asked our expert,
9 Professor Wittrup, during recross examination, that's not the only word
10 difference that's in there. And the word "ligating" is -- happens to be in
11 there. Mr. Huntington sort of breezed over that and made wind of it. But it
12 is ligating step-wise.

13 Ligating is not in claim 1, either. Ligating is a subset of joining
14 fragments, polynucleotide fragments together. Using, for example, a
15 particular enzyme that causes the covalent body between those two
16 fragments.

17 So, I think just to say, well, the only difference there is
18 step-wise, and so step-wise must be a narrower embodiment within
19 non-stochastically assembling. And that is the end of the story. I don't
20 think that is.

21 JUDGE TORCZON: What does step-wise do, then, if it's not
22 narrowing?

23 DR. PEREIRA: Sorry?

24 JUDGE TORCZON: Why add the word "step-wise" if it is not
25 doing anything?

1 DR. PEREIRA: It's just a way to define the methodology, like
2 getting blocks, adding step-wise. I am not sure I understand your question.

3 JUDGE TORCZON: I guess either step-wise or ligating are
4 the same concept, if you use one, you have to use the other? Adding
5 step-wise is doing some function in that amendment. So, what is the
6 function of step-wise in that amendment?

7 DR. PEREIRA: Meaning function in terms of the
8 methodology? Or why --

9 JUDGE TORCZON: Yes, what is the point of the amendment
10 if it doesn't mean anything other than --

11 DR. PEREIRA: To spell out the invention and the claim, and
12 defines ligating blocks step-wise.

13 JUDGE LANE: Why did you change from the word
14 "non-stochastically" to "step-wise"?

15 DR. PEREIRA: Well, at the time, as Your Honor, knows -- at
16 the time when we submitted the reissue it was a request to sort of have it as
17 a contingency, if you will, for this interference, recognizing what the
18 arguments on both sides were. And recognizing that you may not agree
19 with us.

20 And as much as like our motion two is contingent on motion
21 one, our reissue is largely contingent on your decision on motion one, in
22 terms of what the meaning of non-stochastically assembling means.

23 JUDGE TORCZON: Okay. As I understood Mr. Huntington's
24 argument, though, he wasn't -- part of his argument was that you were trying
25 to narrow it, I suppose. But part of it was if you had meant step-wise, you

Interference 105,532

1 always had the chance to say it. We saw under sort of an In re Morse
2 concept where, if you mean something, it is incumbent on the applicant as
3 the drafter of the claim to say what they mean.

4 You always could have said step-wise. Non-stochastically is at
5 least amenable to a broader interpretation. Why should we give it a
6 narrower interpretation when all along it could have been given the
7 narrower wording?

8 DR. PEREIRA: I am not sure I followed the question. Why
9 did we use step-wise or why wasn't step-wise used originally and not
10 non-stochastically assembling? Is that your question?

11 JUDGE TORCZON: The way I understand Mr. Huntington's
12 point, at least one of his points, there was -- Short could have used the
13 phrase step-wise all along. And since they didn't, it's too late, essentially. I
14 guess my question would be why. Was there any impediment to using
15 step-wise before, or why isn't that used instead if a broader construction was
16 intended?

17 DR. PEREIRA: I don't know I necessarily know what was
18 intended back in whenever those -- '97 or '98 -- whenever that amendment
19 was filed. But it is not uncommon to use different phraseology
20 for -- basically for the same thing in different claim contexts within a single
21 patent. And that --

22 JUDGE TORCZON: It's terribly unhelpful for people trying to
23 construe the claims. I mean, if it means the same thing, it ends up
24 obfuscating. We've got to assume it means different things.

1 DR. PEREIRA: Right. But again, I think we are just -- if
2 claim 13, I think, is in the reissue -- and said simply assembling step-wise,
3 then maybe you might have a bigger problem. But I still think that there
4 is -- could have simply used ligating non-stochastically or ligating building
5 blocks, assembling non-stochastically. If that's better -- or some phrase like
6 that.

7 I don't really seeing that having a real bearing on what
8 assembling non-stochastically means in that particular claim that uses the
9 word step-wise, and uses some other words that are different from claim 1
10 as well. You know, ligating is a sub-embodiment of assembling. So.

11 Thank you.

12 JUDGE LANE: Thank you. Before we go off the record, I
13 neglected to introduce who we have with us -- Deborah Katz, our patent
14 attorney.

15 Off the record.

16 (Whereupon, at 3:00 p.m., the hearing was concluded.)

17 * * * * *